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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/642,844

08/18/2003

Alfred J. Lewy

90,559-T

3196

7590 12/02/2008  
McDonnell Boehnen Hulbert & Berghoff  
32nd Floor  
300 S. Wacker Drive  
Chicago, IL 60606

EXAMINER

ROYDS, LESLIE A

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

12/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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| APPLICATION NO./<br>CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR /<br>PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
|---------------------------------|-------------|---|---------------------|
| 10/642,844                      | 8/18/2003   | LEWY ET AL.                                       | 90,559-T            |

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**EXAMINER**

Leslie A. Royds

| ART UNIT | PAPER |
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| 1614 | 20081119 |
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DATE MAILED:

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**Commissioner for Patents**

**NOTICE OF NON-RESPONSIVE AMENDMENT**

Applicant's amendments and remarks filed August 21, 2008 have been received and entered into the present application. However, Applicant's amendments to the claims fail to comply with the requirements of 37 C.F.R. 1.121[c].

37 C.F.R. 1.121[c] states: "Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being cancelled...All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended", and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletions of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived."

Applicant presented an amendment to instant claim 9 in the claim listing filed June 4, 2008 to read: "A method for achieving a circadian-rhythm phase-delaying effect in a human...wherein plasma melatonin or equivalent agonist levels are elevated during a time interval beginning before and extending past the human's endogenous melatonin offset time." However, the subsequent claim listing filed August 21, 2008 fails to clearly set forth the text of present claim 9 relative to this immediate prior version of the claims filed June 4, 2008. Specifically, Applicant presents claim 9 in the claim listing of August 21, 2008 as "Previously Presented" and directed to "A method for achieving a circadian-rhythm phase-delaying effect in a human...wherein plasma melatonin or equivalent agonist levels are elevated during a time interval that overlaps CT0." This limitation "wherein plasma melatonin or equivalent agonist levels are elevated during a time interval that overlaps CT0" was not previously pending in the immediate prior version of the claims and Applicant has not indicated it as newly added and deleted the previously pending limitation of "wherein plasma melatonin or equivalent agonist levels are elevated during a time interval beginning before and extending past the human's endogenous melatonin offset time". As a result, Applicant has failed to clearly set forth the subject matter that Applicant intends to be pending and under examination at this time.

Accordingly, Applicant is required, in reply to this notice, to submit a clear and complete listing of all pending claims amended relative to the immediate prior version of the claims and to rectify the inconsistencies noted supra with regard to instant claim 9 as set forth in the papers filed August 21, 2008. Note that, if Applicant wishes to amend instant claim 9, the claim text must be amended relative to the claim listing of June 4, 2008 and must include appropriate strike-through and underlining to indicate what limitations are deleted and which are newly added.

Since the above-mentioned response appears to be a bona fide attempt to reply, Applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction, as well as a proper response to the previous Office Action, in order to avoid abandonment. Extensions of this time period under 37 C.F.R. 1.136(a) are available.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Leslie A. Royds, whose telephone number is (571)-272-6096. The Examiner can normally be reached Monday through Friday, 9:00 AM to 5:30 PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ardin H. Marschel, can be reached on (571)-272-0718. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

/Ardin Marschel/  
Supervisory Patent Examiner, Art Unit 1614

/Leslie A. Royds/  
Patent Examiner, Art Unit 1614